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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/089,901	06/03/1998	MAMORU SHOJI	YAMAPO575US	3322

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT

PAPER NUMBER

2653

DATE MAILED: 08/27/2004

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/089,901

Applicant(s)

SHOJI ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.



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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/9/2004 has been entered.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised

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of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 (c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1,2,7,9,11,12,17 and 19 are rejected under 35 U.S.C. 103. (a) as being unpatentable over the acknowledged prior art JP 4-141827 further considered with Moriya et al and all further considered with either Senshu or Itoi.

The acknowledged prior art discloses a basic parameter testing/calibrating capability wherein the parameter selected is one of power, which is equivalent to intensity.

The acknowledged prior art lacks any mention of a spiral track environment and that information can be recorded on/in all areas.

Such a capability is well known as taught by Moriya et al.

With respect to the newly inserted wherein clause, the examiner interprets such to mean that the recording of the information is continuously performed from the land to the groove (or alternatively from the groove to the land).

Either the Senshu or the Itoi reference teaches such a recording technique.

In Senshu applicants' attention is drawn to col. 4 lines 56-59, or alternatively in the Itoi reference see the description starting at col. 1 line 51 to col. 2 line 5. Either reference teaches the continuous recording of the information from the land to the groove.

It would have been obvious to one of ordinary skill in the art to modify the system of the above noted JP prior art system with the teaching from Moriya et al and both further considered with the teachings from either Senshu or Itoi, motivation is to use the above parameter setting ability with as many different types of records as possible, and hence increase the overall system use. The ability to continuously record the incoming information so as to permit recording at one continuous time and hence reduce overall recording time is considered motivation as taught by either of the references to Senshu or Itoi.

The limitations of claim 2 are considered self-evident.

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For claims 7 & 17, intensity is interpreted as power.

The limitations of claims 9 and 19 are considered inherently present in Moriya et al and no further analysis is made.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection, i.e., the continuously recording ability as further taught by either Senshu or Itoi. For any further analysis, applicants' attention is drawn to the Board of Appeals decision of 4/21/04.

3. Claims 3 and 13 are rejected under 35 U.S.C. 103 (a) as being unpatentable over the art as applied to claims 1,2,11 and 12 above and further considered with the acknowledged prior art.

Applicants' have admitted that such a capability is well known in the art – see page 29 of the disclosure. No further rebuttal is deemed necessary.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection, i.e., the continuously recording ability as further taught by either Senshu or Itoi.

4. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 3 and 13 above, and further in view of Johann et al.

The ability of establishing an average of a parameter is considered well known as taught by the Johann et al reference.

It would have been obvious to one of ordinary skill in the art to modify the basic parameter setting/optimizing/establishing capability of the references as relied upon with respect to the parent claim with the teaching from Johann et al, motivation is to obtain a better optimization parameter.

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Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection, i.e., the continuously recording ability as further taught by either Senshu or Itoi.

5. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 4 above, and further in view of the acknowledged prior art.

Again, the limitations of claims 5 and 15 are acknowledged as being well known by applicants, see page 29 of the specification. Use thereof in the overall system is considered to be obvious to one of ordinary skill in the art, motivation is to perform the parameter calibration/optimization technique in an acknowledged system.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection, i.e., the continuously recording ability as further taught by either Senshu or Itoi.

6. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 3 and 13 above, and further in view of the acknowledged prior art.

Applicants have acknowledged the prior art on page 29 of the specification referring to the ability to perform the optimization/calibration at separate times/locations. Hence the examiner interprets the claim limitation "are performed at two positions spaced apart" as having been met. Additionally, due to the spiral track layout of Moriya et al, the ability of having information on both the lands and the grooves inherently meets the above language as well.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection, i.e., the continuously recording ability as further taught by either Senshu or Itoi.

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7. Claims 8,10,18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 11 above, and further in view of Pierzykoski et al.

The ability of having a plurality of parameters optimized is considered merely a duplication of effort as taught by Pierzykoski et al, which teach the optimization for a plurality of parameters in this environment.

It would have been obvious to one of ordinary skill in the art to modify the basic parameter setting/optimization/establishing capability found in the above system with respect to the parent claim with the additional capability of doing so for a plurality of parameters as taught by Pierzykoski et al, motivation is to perform such optimization techniques on as many parameters in the system that require correction and hence improve the overall system response.

Furthermore, Pierzykoski et al discuss symmetry – see column 10 line 8 plus as one of those parameters.

In the above rejections, the examiner notes, that claim 11 –20 are methods which parallel the apparatus limitations as found in claims 1 – 10. The examiner considers the method limitations to be met when the system is operational.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection, i.e., the continuously recording ability as further taught by either Senshu or Itoi.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamaguchi et al – see the discussion with respect to col. 2 line 49 to col. 3 line 5 which also discloses the ability of continuously recording from land to groove –i.e., without interruption(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
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AMP